

REMARKS

In response to the Office Action dated July 15, 2004, Applicants respectfully request reconsideration based on the above claim amendment and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1-2 have been amended, and claims 3-13 have been canceled without prejudice. Support for the amendment can be found in the entire specification. No new matter has been added by the amendment.

*Claim Priority*

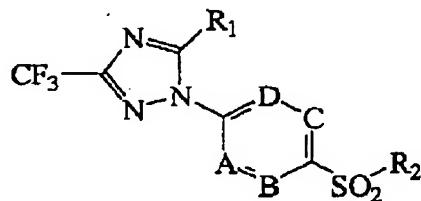
The Examiner states in the Office Action Summary that the priority documents had not been submitted to the patent office. Applicants submitted the priority documents on June 27, 2003. A copy of the documents that were submitted is attached hereto. In addition, Applicants submit herewith a copy of the stamped postcard that indicates that the patent office received the priority documents on June 27, 2003. Applicants request that the Examiner acknowledge that all of the certified copies of the priority documents have been received.

*Claim Rejections Under 35 U.S.C. § 102*

Claims 1-2 stand rejected under 35 U.S.C. § 102(a), (b) and/or (e) as being anticipated by Sakya et al., US2003/0125368 (hereinafter "Sakya") and Pascal et al., EP 1,099,695 (hereinafter "Pascal") for the reasons stated on page 3 of the Office Action. Applicants respectfully traverse the rejection.

Claim 1 is a 1,2,4-triazole derivative represented by formula 1:

Formula 1



wherein: R<sub>1</sub> is a C<sub>3</sub>-C<sub>6</sub> cycloalkyl group; a C<sub>3</sub>-C<sub>6</sub> cycloalkenyl group; a phenyl group; a phenyl group substituted with one or more selected from the group consisting of a C<sub>1</sub>-C<sub>6</sub> alkyl group, a C<sub>1</sub>-C<sub>6</sub> haloalkyl group, a C<sub>1</sub>-C<sub>6</sub> alkoxy group, a C<sub>1</sub>-C<sub>6</sub> haloalkoxy group, a halogen group, an amino group, a monoalkylamino group, a dialkylamino

group, a nitro group, and a cyano group; a styrenyl group; a C<sub>1</sub>-C<sub>6</sub> alkoxy styrenyl group; or a pyridyl group; R<sub>2</sub> is a methyl group; and A, B, C, or D is independently carbon; or a non-toxic salt thereof.

The Examiner states that examples 1-4 and 6 of Sakya disclose the instant invention. The examples of Sakya, however, disclose sulfonyl aryl triazones containing phenylsulfonylamino substitution at 1<sup>st</sup> position of triazole, whereas the instant claims contain a methanesulfonylphenyl at 1<sup>st</sup> position, instead of methyl substitute. Therefore, the compound of Sakya has different structure from that of claimed invention. Thus, Sakya neither anticipates nor renders the compound as set forth in claims 1-2 obvious.

The Examiner also states that examples 17-27 of Pascal disclose the instant invention. In the examples 17-27 of Pascal, R<sub>4</sub>SO<sub>2</sub> substitution is placed at 5<sup>th</sup> position of triazole and R<sub>2</sub> substitution is placed at 1<sup>st</sup> position of triazole, while R<sub>2</sub>SO<sub>2</sub> substitution, in claim 1, is placed at 1<sup>st</sup> position of triazole and R<sub>2</sub> substitution is placed at 5<sup>th</sup> position of triazole. Therefore, the compound of Pascal is different from the claimed compound. Further, although one could argue that the compound of Pascal could be assumed as an isomer of the claimed compound, isomers are not necessarily suggestive of each other. Isomers having the same empirical formula but different structures are not necessarily considered equivalent by chemists skilled in the art and therefore are not necessarily suggestive of each other. *Ex parte Mowry*, 91 USPQ 219 (Bd. App. 1950). Therefore, the claimed compound is different from that of the compound of Pascal. Thus, Pascal neither anticipates nor renders the compound as set forth in claims 1-2 obvious.

#### ***Claim Rejections Under 35 U.S.C. § 103***

Claims 1-2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teaching of Sakya and Pascal for the reasons stated on pages 3-4 of the Office Action.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was

made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Anigen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). However, as stated above, neither Sakya nor Pascal teaches or suggests the feature "a 1,2,4-triazole derivative represented by formula 1, ..., R<sub>2</sub> is a methyl group; and A, B, C, or D is independently carbon; or a non-toxic salt thereof", as recited in claim 1.

Further, in addition to the structure difference, the claimed compound has different activities from that of Sakya. For example, the compound containing methanesulfonylphenyl substitution at 1<sup>st</sup> position of triazole has superior properties in selectivity for inhibiting COX-2 over COX-1, in comparison with the compound containing phenylsulfonylamino substitution at 1<sup>st</sup> position of triazole. Table 1, on pages 73-74 of the Application show that Example 27 (or 28), having the same structure to that of Example 44 (or 43) except the substitutions at 1<sup>st</sup> position of triazole, shows much higher selectivity for inhibiting COX-2 over COX-1. For example, Example 28 has 2.0 selectivity for inhibiting COX-2 over COX-1, while Example 43 has 0.93 selectivity for inhibiting COX-2 over COX-1. Thus, the compound containing methanesulfonylphenyl substitution at 1<sup>st</sup> position of triazole has also different activity from that of the compound containing phenylsulfonylamino substitution at 1<sup>st</sup> position of triazole. Accordingly, Sakya neither teaches nor suggests the claimed compound as set forth in claim 1.

The claimed compound is also different activities from that of the compound of Pascal. The claimed compound, for example, shows unexpectedly superior in inhibiting COX-1 and COX-2 and in selectivity for inhibiting COX-2 over COX-1, in comparison with the compound of Pascal. Examples 27 and 28 of the Application show 13.8 and 10.1 inhibition rates for COX-1 (1μM) and 16.04 and 28.62 inhibition rates for COX-2 (10nM), respectively. On the contrary, Examples 18 and 17 of Pascal, having different substitutions at 1<sup>st</sup> and 5<sup>th</sup> positions of triazole, show about 5 and 8 inhibition rates for COX-1 (1μM) and about 53 and 44 inhibition rates for COX-2 (1μM), respectively. Therefore, the claimed compound shows superior properties in inhibiting COX-1 and COX-2 as well as in selectivity for inhibiting COX-2 over COX-1 in comparison with the compound of Pascal. Thus, the claimed compound has different structure and activities from those of the compound of Pascal.

Accordingly, the combination of Sakya and Pascal does not render claim 1 obvious, since all of the elements of claim 1 are not taught or suggested by the cited references. Claim 2 is believed to be allowable due to its dependency on claim 1.

***Conclusion***

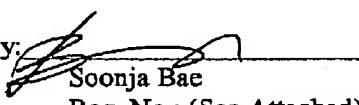
In view of the forgoing amendments and remarks, Applicants submit that this application is in condition for allowance. Early notification to this effect is requested.

If there are any charges due in connection with this response, please charge them to Deposit Account 06-1130.

Respectfully submitted,

CANTOR COLBURN LLP

By:



Soonja Bae

Reg. No.: (See Attached)

Confirmation No. 2215

CANTOR COLBURN LLP

55 Griffin Road South

Bloomfield, CT 06002

Telephone (860) 286-2929

Facsimile (860) 286-0115

PTO Customer No. 23413

Date: December 14, 2004

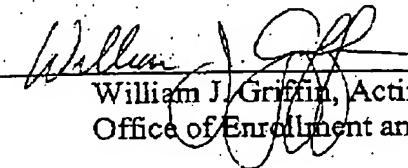
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UNITED STATE PATENT AND TRADEMARK OFFICE

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Expires: July 22, 2005

  
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William J. Griffin, Acting Director  
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**COPY****KOREAN INTELLECTUAL  
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This is to certify that the following application annexed hereto is a true copy from the records of the Korean Intellectual Property Office.

Application Number: Korean Patent 2002-0046551

Date of Application: 07 August 2002

Applicant(s): CJ Corp.

13 March 2003

**COMMISSIONER**

Print Date: 2003/03/14

## [Bibliography]

[Document Name]	Change to informative data of applicant
[Receiver]	Commissioner
[Filing Date]	25 October 2002
[Applicant]	CJ Corporation
[Name]	1-1998-003466-9
[Applicant code]	
[Items to be changed]	Korean Name
[Changed Item]	Cheil Jedang Corporation
[Before change]	CJ Corporation
[After change]	
[Items to be changed]	English Name
[Changed Item]	Cheil Jedang Corporation
[Before change]	CJ Corporation
[After change]	
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[Purpose]	We notice as above according to Art. 9 of the Patent Law, Art. 12 of the Utility Model Law, Art. 28 of the Design Law and Art. 23 of the Trademark Law.

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출원번호 : 10-2002-0046551  
Application Number

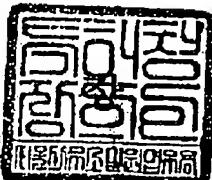
출원년월일 : 2002년 08월 07일  
Date of Application AUG 07, 2002

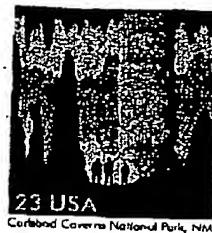
출원인 : 씨제이 주식회사  
Applicant(s) CJ Corp.

2003 년 03 월 13 일

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CANTOR COLBURN LLP  
55 GRIFFIN RD. SOUTH  
BLOOMFIELD, CT 06002

USPS 4 oz - Handwritten address

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THE STAMP OF THE PATENT OFFICE, PLACED HEREON, ACKNOWLEDGES RECEIPT OF:  
Attorney Docket No.: YPL-0057

New U.S. Nonprovisional Patent Application:

In Re:

Il Hwan Cho, et al.

Applicant:

1, 2, 4-TRIAZOLE DERIVATIVE, METHOD FOR  
PREPARING THE SAME, AND PHARMACEUTICAL  
COMPOSITION CONTAINING THE SAME

\*\*\*\*\*  
Utility Patent Application Transmittal (4 pages), Specification and Abstract (100 pages), Preliminary Amendment (30 pages), Executed Declaration and POA (12 pages), Recordation Form Cover Sheet (1 page), Assignment (4 pages), Claim for Priority (1 page), Korean Patent Application No. 2002-0046551 (138 pages), Limited Recognition Under 37 CFR Section 10.9 (b)(1 page), Certificate of Mailing by Express Mail (1 page), Filing Fee-Check \$1,086.00, Check-Recordation Fee-\$40.00 and postcard receipt.

17525 U.S. PTO  
10/608709

Mailed to USPTO, Mail Stop Patent Application, Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313 on June 27, 2003 via Express Mail 06/27/03  
Label No. EV310329973USUS  
Received in the USPTO on: